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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/700,802

11/03/2003

Thomas Poslinski

81099/7114

6271

37123 7590 11/12/2008  
FITCH EVEN TABIN & FLANNERY  
120 SOUTH LASALLE SUITE 1600  
CHICAGO, IL 60603

EXAMINER

SHIBRU, HELEN

ART UNIT

PAPER NUMBER

2621

MAIL DATE

DELIVERY MODE

11/12/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/700,802	<b>Applicant(s)</b> POSLINSKI ET AL.	
	<b>Examiner</b> HELEN SHIBRU	<b>Art Unit</b> 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 8, 11-14 and 16 are cancelled from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected groups, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 08/11/2008.

### ***Response to Amendment***

2. The amendments, filed 03/27/2008 have been entered and made of record. Claims 1-7 are pending.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada (US Pat. No. 2004/0264947A1) in view of Hoang (US PG PUB 2003/0126201 A1) and further in view of Robinson (US Pat. No. 5,592,669).

Regarding claim 1, Okada discloses a method of increasing the available storage space on an electronic storage medium comprising the steps of: selecting a first portion of a file stored on

Art Unit: 2621

the electronic storage medium (see figure 6B where it shows VOB#2, VOB#4, VOB#6 are selected out); and leaving a deallocated portion of memory corresponding to the first portion (see figure 6B level 2 and 3 where it shows the areas occupied by the first portion is empty on the second level of figure 6B and see also paragraph 0724 where it discloses the empty area is called the out area and the out area *logically* include the data of the AV file *that was cut out* , and when the VOB is reproduced the reproduction order is VOB#1, VOB#3, VOB#5, and VOB#7, i.e. the selected portion are unassigned (referring to deallocation).

Claim 1 differs from Okada in that the claim further requires creating and storing in a memory a free memory list for the electronic storage.

In the same field of endeavor Hoang discloses creating and storing free memory block list in the memory (see paragraphs 0039-0041, figures 3 and 4 (step 350-352), and claim 13 where it shows creating and storing free memory block list). Therefore in light of the teaching in Hoang it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Okada by storing free memory list in a memory in order to store and reflect updates.

Claim 1 further differs from the above proposed combination in that the claim further requires copying the selected first portion of the file to the free memory list without copying the second portion of the file.

In the same field of endeavor Robinson discloses copying the selected first portion of the file to the free memory list without copying the second portion of the file (see col. 32 lines 17-24 where it discloses copying a first portion of a first block to a free space of the first memory). Therefore in light of the teaching in Robinson it would have been obvious to modify the

Art Unit: 2621

proposed combination by cutting and pasting only a portion of the file in to an empty area of the storage medium in order to edit the saved file based on user preference.

Regarding claims 2 and 5, Okada discloses the file is an audio file or a video file (see fig. 74).

Regarding claim 3, Okada discloses the selecting the first portion of the file stored on the electronic storage medium creates a plurality of file segments (see figs 6B, 7A-D, 15A-C, and 74).

Regarding claim 4, Okada discloses the step of linking the plurality of file segments together (see paragraphs 0853-0863).

Regarding claims 6 and 7, Okada discloses the electronic storage medium is a memory of a personal video recorder (see fig. 16 and paragraph 0222).

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2621

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571)272-7329.

The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HELEN SHIBRU/  
Examiner, Art Unit 2621  
October 29, 2008

/Thai Tran/  
Supervisory Patent Examiner, Art Unit 2621